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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/591,172	04/26/2007	Mitsuo Sekine	4600-0129PUS1	6068

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EXAMINER	
CRANE, LAWRENCE E	
ART UNIT	**PAPER NUMBER**
1623	

NOTIFICATION DATE	DELIVERY MODE
11/16/2009	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary	Application No.	Applicant(s)	
	10/591,172	SEKINE ET AL.	
	Examiner	Art Unit	
	LAWRENCE E. CRANE	1623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *Auust 3, 2009 (amendment)*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *2,4-10,14 and 15* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *2,4-10,14 and 15* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

The Abstract of the Disclosure is objected to because is does not meet the requirement of the MPEP for US application. Correction is required. See MPEP 608.01(b).

Applicant is reminded of the proper content of an Abstract of the Disclosure.

In chemical patent abstracts, compounds or compositions, the general nature of the compound or composition should be given as well as its use, e.g., "The compounds are of the class of alkyl benzene sulfonyl ureas, useful as oral anti-diabetics." Exemplification of a species could be illustrative of members of the class. For processes, the type reaction, reagents and process conditions should be stated, generally illustrated by a single example unless variations are necessary. Complete revision of the content of the abstract is required on a separate sheet.

Applicant is respectfully requested to amend the abstract because the present abstract does not describe all of the reactants necessary to execute the claimed process .

Applicant's arguments with respect to the Abstract have been considered but are moot in view of the new grounds of objection. This new ground of objection was necessitated by applicant's incompletely descriptive amendments.

Claims **1 and 11-13** were previously cancelled, claim **3** was newly cancelled, claims **2, 6 and 8-10** have been amended, the Abstract has been amended, the disclosure has been amended at page 1, and new claim **15** has been added as per the amendment filed August 3, 2009. No additional or supplemental Information Disclosure Statements (IDSs) have been filed as of the date of this Office action.

Claims **2, 4-10 and 14-15** remain in the case.

Note to applicant: when a rejection refers to a claim **X** at line y, the line number "y" is determined from the claim as previously submitted by applicant in the most recent response including ~~lines deleted by line through~~.

35 U.S.C. §101 reads as follows:

> "Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title."

Claims **10 and 14** are rejected under 35 U.S.C. §101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. §101. See for example *Ex parte Dunki,* 153 USPQ 678 (Bd. App., 1967) and *Clinical Products, Ltd. v. Brenner,* 255 F. Supp. 131, 149, 149 USPQ 475 (D.D.C. 1966).

In claims **10 and 14** the terms "use" and "used" need to be replaced with alternative terminology that is not derived from the verb
-- to use --.

Applicant's arguments filed August 3, 2009 have been fully considered but they are not persuasive.

Examiner notes with appreciation the correction of claims **2 and 9**. However, claims **10 and 14** remain uncorrected.

Claims **2, 4-10 and 14-15** are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim **2** the term "acid catalyst" is generic to a vast array of compounds most of which are not applicable as catalyst for the instant claimed process; e.g. sulfuric acid, etc., etc. For this term to accurately describe the process, a listing of appropriate compounds that are actually activators should be added to the claim by amendment.

Applicant's arguments filed August 3, 2009 have been fully considered but they are not persuasive.

Applicant has not argued specifically in response to the above rejection. Therefore, the above rejection is found to remain valid and has been repeated.

In claims **4 and 7** the terms "HOBt-derivative" and "phenol analogue" are both indefinite for failure to define the metes and bounds of the included terms "derivative" and :"analogue."

Applicant's arguments filed August 3, 2009 have been fully considered but they are not persuasive.

Applicant has argued that the noted terms are defined in the disclosure at paragraphs [0008] and [0009]. Examiner has inspected the noted paragraphs and has found the open ended terms "such as" and "for example," terms that violate 112, second paragraph, because said terms admit to no adequately defined metes and bounds. Therefore, the above rejection has been found to remain valid and for this reason has been repeated.

The following rejections are newly advanced in view of applicant's amendments.

In claims **2 and 15** the newly added terminology fails to completely describe the minimum reactants required to execute the instant claimed process. Clarification by the addition to the noted claims of the necessary minimum of details necessary to describe the chemical process being claimed is respectfully requested.

Applicant's arguments with respect to claims **2-10 and 14** have been considered but are moot in view of the new grounds of rejection. This new ground of rejection was necessitated by applicant's amendments.

After reviewing the previous grounds of rejection over prior art and applicant's arguments, examiner concurs with applicant's arguments and therefore hereby withdraws the art rejections.

Claims **2, 4-10 and 14-15** would be allowable if rewritten or amended to overcome the rejections under 35 U.S.C. §101 and §112 set forth in this Office action.

Examiner regrets that the negotiations for a possible allowance with applicant's representative did not bear fruit. Examiner is available to make another attempt at the convenience of applicant's representative.

Applicant's amendment necessitated the new grounds of rejection. Accordingly, **THIS ACTION IS MADE FINAL**. Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. §1.136(a).

A shortened statutory period for response to this final action is set to expire THREE MONTHS from the date of this action. In the event a first response is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory

period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 C.F.R. §1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for response expire later than SIX MONTHS from the date of this final action.

Papers related to this application may be submitted to Group 1600 via facsimile transmission (FAX). The transmission of such papers must conform with the notice published in the Official Gazette (1096 OG 30, November 15, 1989). The telephone number to FAX (unofficially) directly to Examiner's computer is 571-273-0651. The telephone number for sending an Official FAX to the PTO is 571-273-8300.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner L. E. Crane whose telephone number is **571-272-0651**. The examiner can normally be reached between 9:30 AM and 5:00 PM, Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. S. Anna Jiang, can be reached at **571-272-0627**.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group 1600 receptionist whose telephone number is **571-272-1600**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status Information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see < http://pair-direct.uspto.gov >. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866-217-9197** (toll-free).

LECrane:lec
11/09/2009

/LAWRENCE E. CRANE/

Primary Examiner, Art Unit 1623

L. E. Crane
Primary Patent Examiner
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